

### **REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. With this amendment, claim 1 has been amended, no claims have been cancelled, and no claims have been added. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier. Thus, claims 1-10 remain pending in the application, with claims 3-6 withdrawn from consideration.

#### **Claim Rejections - 35 USC § 112**

Claims 1-2 and 7-10 were rejected under 35 U.S.C. 112, second paragraph, as being confusing, because of the “subsequently mixing the epoxy silane represented by the general formula (a1), the carboxylic acid represented by formula (a2), the metal salt of the carboxylic acid represented by formula (a2) and water” description for the process step is allegedly not differentiated. Claims 1-2 and 7-10 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically the phrase “subsequently mixing the epoxy silane represented by the general formula (a1), the carboxylic acid represented by formula (a2), the metal salt of the carboxylic acid represented by formula (a2) and water” allegedly lacks written description in the specification. Applicants respectfully traverse this rejection.

Independent claim 1 has been amended remove the phrase “subsequently mixing the epoxy silane represented by the general formula (a1), the carboxylic acid represented by formula (a2), the metal salt of the carboxylic acid represented by formula (a2) and water.” Therefore, the rejection is moot.

#### **Claim Rejections - 35 USC § 102**

Claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura et al. (US 2004/0198916). Applicant respectfully traverses this rejection.

Nakamura does not anticipate claim 1 because Nakamura does not teach all of the features recited in claim 1. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegall Bros. v.*


*Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claim 1 has been amended to recite “wherein the reaction is carried out in presence of **0.3 wt%** or more water.” Support for this feature can be found in paragraph [0045] of the specification and Table I. In the example cited by the Examiner (paragraph [0067] of Nakamura), Nakamura teaches mixing 101 g of J1 (the silicone compound), 0.24 g of hydroquinone, 1.95 g of KOH and 51.7 g of methacrylic acid. Using the examiner's proffered purity of KOH (10-15% water), Nakamura teaches a process having 0.126-0.189% water. Thus, Nakamura does not anticipate the process for producing of a silicone compound “wherein the reaction is carried out in presence of **0.3 wt%** or more water” as recited in claim 1.

### **Claim Rejections - 35 USC 103**

Claims 1-2 and 7-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al. (US 2004/0198916), in view of Inoue et al. (US 5,891,356). Applicants respectfully traverse this rejection.

The combination of Nakamura and Inoue would not have rendered obvious claims 1-2 and 7-10 to one of ordinary skill in the art at the time of the invention because the combination of Nakamura and Inoue does not teach or suggest all of the recited features of independent claim 1. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). *See also* MPEP 2143.03. As discussed above, independent claim 1 has been amended to recite “wherein the reaction is carried out in presence of **0.3 wt%** or more water.” Paragraph [0045] of the present specification teaches that the water present is preferably greater than 0.3% wt%. Indeed, the actual examples illustrated in Table I demonstrate that 0.3 wt% or more water provides purities superior to the comparative examples and prior art range of 85-89% discussed in paragraph [0004] of the present specification. The example of Nakamura cited by the Examiner, in contrast, teaches a process having 0.126-0.189% water. Further, Inoue does not fill the gap in Nakamura. Inoue teaches a homogeneous electrorheological fluid which comprises a liquid crystal compound in which a plurality of liquid crystal groups are bonded to a molecular chain either directly or via a spacer, or comprises a lyotropic liquid crystal comprising a solute and a solvent.” (Abstract). Inoue does not teach or suggest a process for producing of a silicone compound “wherein the reaction is

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carried out in presence of **0.3 wt%** or more water” as recited in claim 1. Indeed, Inoue was only cited by the examiner for teaching purifying silicone compounds with a chromatography column. (Office Action, p.7, l.6-7). Simply, the combination Nakamura and Inoue does not teach a process for producing of a silicone compound “wherein the reaction is carried out in presence of **0.3 wt%** or more water” as recited in claim 1. Applicants therefore respectfully request withdrawal of the rejection.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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